

REMARKS

This Amendment Under 37 CFR 1.111 responds fully to the Office Action mailed April 4, 2007, from the US Patent Office in this case. Applicants hereby affirm the telephonic affirmation of the provisional election with traverse, by Robert Trepp of IBM, on February 1, 2007, thereby electing to prosecute the invention of Group II, claims 3-5, 24 and 31. Claims 3-5, 24 and 31 remain pending for prosecution hereinafter, where claim 3 is the sole independent claim.

In the April 4, 2007, Office Action, claims 3-5, 24 and 31 were rejected under 35 USC §102(b) as unpatentable over US Patent No. 5,848,396 to Gerace (Gerace). With respect to independent claim 3, the Examiner asserts that Gerace discloses a content registration/management system including content registration request reception means, for receiving a request for content registration from a content provider that provides content (Figs. 5a-5d; col. 3, lines 4-20); identifier provision means, for setting an identifier, based on said request that is received, to be added to said content that is to be provided a user terminal, and for providing said identifier to a content provider (col. 17, line 52-col. 18, line 10; col. 6, line 57-col. 7, line 23); and a content ledger database, for storing information related to said identifier provided said content provider (col. 33, line 35-col. 34, line 27).

Applicants have carefully studied Gerace, the portions of Gerace's cited to support the rejection of independent claim 3 under Section 102(b) and applicants' Specification and pending claims at issue by the instant Office Action, and respectfully assert that Gerace does not teach or suggest each of the elements of applicant's sole pending independent claim 3, for at least the following reasons. Applicants' invention comprises a content registration/management

system whereby content providers, such as owners of rights to a popular musical composition, will allow their content to be downloaded to users for free, but the content owner is compensated by advertisers who have an advertising identifier inserted with the content that is downloaded. The user gets the free content, and the inserted identifier (i.e., advertisement), wherefore the advertiser pays the content owner the equivalent of a royalty that such content owner might normally be entitled to from the user by the “free use” (for example, what the content owner might be accorded under ASCAP rules).

Applicants’ inventive content registration management system (such as set forth in independent claim 3) allows the advertiser to choose which content (freely downloadable content) he/she wishes to include its advertising identifier in. The content with the advertisement identifier could then be downloaded to the content-user for free, but the content-owner still gets paid by the advertiser. There is no need for preparing profiles, or conducting the other elements of the Gerace techniques, for targeting particular user groups based on psychological or user-use profiling, itself based on tracked user computer activity or viewing habits. For example, where the free downloadable content is music, an advertiser using the inventive system only need decide if he/she wants their advertising identifier downloaded with, for example, a U2 recording (a content) or a Celine Dion recording (another content), to direct such advertising to groups who prefer U@ to Celine Dion, or vice versa.

Applicants independent claim 3 recites one embodiment of the invention as a content registration/management system. The claimed system provides that an advertiser makes content registration requests via content registration request reception means, in order to choose which content that it wishes to incorporate it’s advertising identifier. The first element of applicants’ claim 3 content registration/management system specifically calls out: “content

registration request reception means, for receiving a request for content registration from a content provider that provides content.” The content registration management system further includes an element defined a identifier provision means that sets the identifier (advertising identifier) that will be included with the content as identified by the advertiser’s request. That is, the second element of applicants’ claim 3 content registration management system calls out: identifier provision means, for setting an identifier, based on said request that is received, to be added to said content that is to be provided a user terminal, and for providing said identifier to a content provider. The claim 3 content registration management system further stores information relating to the identifier provided by the content provider. Hence, the last element called out by applicants’ content registration management system of claim 3 is: a content ledger database, for storing information related to said identifier provided by said content provider.

Applicants understand that Gerace is readily distinguishable from such claimed content registration management system. That is, applicants find that Gerace teaches targeted marketing by the use of agate information in order to determine a behavioral or psychographic profile of a computer user. The Gerace targeted marketing system and method, by its use of the behavioral or psychological profile, is distinguished from both applicants’ invention as claimed and known demographic profiling by providing (i) a data assembly for displaying customized agate information to a computer user, and (ii) a tracking and profiling member for recording user activity with respect to agate information displayed through the data assembly. Gerace’s tracking and profiling member, over time, holds a history and/or pattern of user activity, which in turn is interpreted as the member’ habits and/or preferences for the advertising purposes. To that end, a psychographic profile is inferred from the recorded activities in the tracking and profiling

member. The tracking and profiling member records presentation (format) preferences of the user based on their viewing activity.

Preferences with respect to color schemes, text size, shapes, and the like are recorded as part of the psychographic profile of a user. In turn, the psychographic profile enables the data assembly to customize presentation (format) of agate information, per user, for display to the user. The data assembly displays the agate information and/or advertisements combined in a common screen view or separately in respective screen views, which advertisements are stored in an advertisement module and displayed to users in accordance with the psychographic profile of the user. The tracking and profiling member also records demographics of each user, whereby the data assembly is able to transmit advertisements for display to users based on psychographic and demographic profiles of the user to provide targeted marketing.

Gerace further includes an advertisement module that records history of users viewing the advertisements. For each advertisement, the module records (i) number of times viewed by a user; (ii) number of times selected for further information by a user, and/or (iii) number of purchases initiated from display of the advertisement to a user. In addition, a subroutine coupled to the module performs a regression analysis on the recorded history of users viewing the ads. The subroutine refines profiles of target users based on the regression analysis, which weights the relative importance of psychographic and/or demographic characteristics of users. As such, over time, the advertisements become better targeted to users having an interest in said information (content and presentation or format of ad), thereby automatically targeting of audiences (target users) and self-tailoring of target profiles.

Gerace does not disclose or even suggest a content registration/management system including content registration request reception means, for receiving a request for content registration from a content provider that provides content, identifier provision means, for setting an identifier, based on said request that is received, to be added to said content that is to be provided a user terminal, and for providing said identifier to a content provider and a content ledger database, for storing information related to said identifier provided said content provider.

For that matter, while the Examiner then asserts that Gerace discloses a content registration/management system at Figs. 5a-5d, and at col. 3, lines 4-20, including content registration request reception means, for receiving a request for content registration from a content provider that provides content, applicants just do not find the support at the cited text as asserted. Gerace's Figs. 5a-5b illustrate a set of sponsor objects 33a, ad package objects 33b, ad series objects 33c and ad objects 33d. Nowhere in Figs. 5a-5d show or even suggest applicants' element comprising content registration request reception means, for receiving a request for content registration from a content provider that provides content. More, the text at col. 3, lines 4-20 describes how Gerace's sponsor object categorizes advertisements or other sponsor provided info according to content and presentation, and how sponsor and user objects track how many times each piece of advertisement information is shown to, is selected by and/or spawns a purchase by users. Applicants' claimed content registration request reception means, for receiving a request for content registration from a content provider that provides content is not disclosed or even implied by the text at col. 3.

And while the Examiner asserts that Gerace's text at col. 17, line 52-col. 18, line 10, and at col. 6, line 57-col. 7, line 23, discloses applicant's claimed identifier provision means, for setting an identifier, based on said request that is received, to be added to said content that is

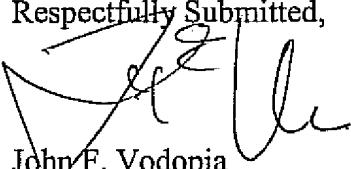
to be provided a user terminal, and for providing said identifier to a content provider, applicants again must respectfully disagree. The text at col. 17, line 52-col. 18, line 10, merely discloses that portion of the Gerace technique that includes sponsor log-on for browsing the agate information and advertisements for the end user, including entering demographic targets, completion of the advertiser template, and discusses how the Gerace program combine the regression analysis with their weighting technique for automatic optimization (as defined by Gerace). Gerace at col. 6, line 57-col. 7, line 23, merely discloses its user account history object, action history object, user session object, etc. Nowhere within the Gerace text cited is their found applicants' identifier provision means, for setting an identifier, based on said request that is received, to be added to said content that is to be provided a user terminal, and for providing said identifier to a content provider.

Finally, while the Examiner asserts that Gerace at col. 33, line 35-col. 34, line 27, discloses applicants' claimed content ledger database, for storing information related to said identifier provided said content provider, applicants again respectfully disagree. Gerace's Appendix IV provides a list of advertising reporting features, detailed package reports, demographic response rates, psychographic profiling, mapping, regression demographics and customer reports, no part of which can, with all due respect, can be considered the same or the equivalent of applicants' claimed content ledger database, for storing information related to said identifier provided said content provider.

Applicants, therefore, respectfully assert that Gerace does not disclose, teach or suggest each of the elements of independent claim 3, as required under 35 USC §102(b), and request withdrawal of the rejection of independent claim 3 under Section 102(b) in view of Gerace. Claims 4, 5, 24 and 31 depend from independent claim 3 and are patentable therewith.

Conclusion

It follows that each of pending claims 3-5, 24 and 31, is patentably distinct from Gerace under Section 102(b). If the Examiner believes that a telephone conference with applicant's attorneys would be advantageous to the disposition of this case, the Examiner is asked to telephone the undersigned.

Respectfully Submitted,

John F. Vodopia
Registration No. 36,299
Attorney for Applicants

SCULLY, SCOTT, MURPHY & PRESSER, P.C.
400 Garden City Plaza, Suite 300
Garden City, NY 11530
(516) 742-4343

JFV:gc